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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/797,589	06/09/2010	Dominic Crapuchettes	5040.0004	5107

48222 7590 05/24/2017

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EXAMINER

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ART UNIT	PAPER NUMBER
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3711

NOTIFICATION DATE	DELIVERY MODE
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05/24/2017

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DOMINIC CRAPUCHETTES
and NATHANAEL BREEZE HEASLEY

Appeal 2015-000442
Application 12/797,589
Technology Center 3700

Before CHARLES N. GREENHUT, JASON W. MELVIN, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

KORNICZKY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants Dominic Crapuchettes and Nathanael Breeze Heasley¹ appeal under 35 U.S.C. § 134 from the Examiner’s decision, as set forth in the Final Action dated August 14, 2013 (“Final Act.”), rejecting claims 16–33.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE CLAIMED SUBJECT MATTER

The claims are directed to “multiplayer question and answer games.” Spec. 1:11–12. Independent claims 16 and 31 are reproduced below:

16. A method of playing a game, comprising:
 - prompting a player to generate an answer choice with a numeric value in response to a question;
 - arranging each answer choice on a playing surface from the smallest to the largest numeric value;
 - selecting an answer choice as the winning answer.
31. A game system, comprising:
 - an input device to receive an answer choice having a numeric value generated by a player;
 - a computer processor to sort each answer choice from smallest to largest, assign each answer choice to an answer position and to calculate a weighted value that increases for each answer position that increases as the answer position further deviates from a mean answer position; and
 - a display screen to display each answer choice arranged from the smallest to the largest numeric value;
 - wherein the processor selects one answer choice as the winning answer and awards a player that selects the winning answer in an amount that varies according to the weighted value.

¹ Appellants identify North Star Games LLC as the real party in interest. Appeal Brief dated March 21, 2014 (“Br.”), 4.

² Claims 1–15 are cancelled. *Id.* at 18 (Claims App.).

REJECTIONS

The Examiner made the following rejections:

1. Claims 31–33 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite.
2. Claims 16–33 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Appellants seek our review of these rejections.

DISCUSSION

The Rejection of Claims 31–33 as Being Indefinite

Appellants argue claims 31–33 as a group. Br. 11–12. We select independent claim 31 as the representative claim, and dependent claims 32 and 33 stand or fall with claim 31. 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that claims 31–33 are indefinite because they combine two statutory classes of invention, and the scope of the claims is unclear for infringement. Final Act. 2–4; Ans. 3–4. According to the Examiner,

In the instant case, it would not be clear if infringement would occur by one having a computer programmed with the game, but does NOT play the game and perform the steps. It is further not clear if a player using such a machine, effectively performing the steps, would be infringing. . . . Here the claim recites a “system” which can be a machine as in a kit or a way of doing something as in a process. The body goes on to recite both a combination of elements as in an apparatus claim and steps of playing a game as in a process. As such, the construction of the instant claim is not considered to clearly define the metes and bounds of the invention that he wishes to exclude others from practicing.

Final Act. 2–3. The Examiner further explains that the scope of infringement is unclear:

In the instant claim 31, one cannot determine if applicant is seeking protection on the combination of the computer elements being recite[d], the functions they perform[,] or both. Does the machine need to be performing the recited function in order to be infringed or does it just need to be capable of performing such functions? Any game machine with an input, processor and display has the capability of being programmed to perform the functions recited and would appear to arguably infringe. Does a machine while not in use infringe? Does a computer not programmed with the recited functions being used over the internet to play the game programmed on a website infringe?

Ans. 3–4.

In response to the Examiner, Appellants recast the Examiner’s findings as asserting that “any combination of two statutory classes of invention results in making the claim indefinite.” Br. 11. Appellants assert that claim 31 “recites three pieces of hardware that include an input device, a computer processor, and a display screen” (Br. 12), and there “are no process steps recited in claims 31–33. Each element recites a hardware limitation (input device, computer processor and display screen) and thus, there is no mixing of statutory classes” (Br. 13).

We agree with the Examiner that claim 31 mixes “system” and “process/method” limitations. The Examiner correctly finds that (1) “system” claim 31 is also an “apparatus” claim, and (2) the limitation “wherein the processor selects one answer choice as the winning answer and awards a player that selects the winning answer in an amount that varies

according to the weighted value” is a process or method step. Ans. 3.
Appellants’ argument does not identify error by the Examiner.

Furthermore, Appellants do not address the Examiner’s conclusion that the scope of claim 31 is unclear when viewed from the perspective of the potential infringer. A single claim which claims both an apparatus and the method steps of using the apparatus may be indefinite under 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, second paragraph. *See In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303 (Fed. Cir. 2011). In *Katz*, a claim directed to “[a] system with an interface means for providing automated voice messages . . . to certain of said individual callers, *wherein said certain of said individual callers digitally enter data*” was determined to be indefinite because the italicized claim limitation is not directed to an element of the system, but rather to actions of the individual callers, which creates confusion as to when direct infringement occurs. *Katz*, 639 F.3d at 1318 (citing *IPXL Holdings v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (in which a system claim that recited “an input means” and required a user to use the input means, was found to be indefinite because it was unclear “whether infringement . . . occurs when one creates a system that allows the user [to use the input means], or whether infringement occurs when the user actually uses the input means.”)) ; *see also In re Lyell*, 17 USPQ2d 1548 (BPAI 1990) (claim directed to an automatic transmission work stand and the method of using it held ambiguous and properly rejected under 35 U.S.C. § 112, second paragraph). Here, as stated above, claim 31 recites system and process/method limitations. Appellants do not address the Examiner’s conclusion that, in claim 31, “one cannot determine if applicant is seeking protection on the

combination of the computer elements being recite[d], the functions they perform[,] or both,” and, thus, do not show error by the Examiner. Ans. 3.

For the reasons above, the rejection of claim 31 is sustained. Claims 32 and 33 fall with claim 31.

*The Rejection of Claims 16–33
as Directed to Non-statutory Subject Matter*

The Examiner finds that the claims 16–33 are directed to an abstract idea for the “rules for playing a game.” Final Act. 5; 6 (“the claims are considered ‘rules’ for playing a game that can be performed by human thought alone and, as such, is [sic] considered merely an abstract idea”); Ans. 6 (“Rules for playing games . . . are clearly dealing with an abstract idea”). The Examiner also finds that using the “physical objects” recited in the claims (e.g., playing surface (claim 16), computer processor (claims 31, 20), input device (claim 31), display screen (claims 17, 31), answer card (claim 18), keyboard (claim 19), game board (claim 21), game surface (claim 22), playing surface (claim 23), display surface (claim 24)) to apply the abstract idea does not transform the abstract idea into patent eligible subject matter. Final Act. 4–8; Ans. 4–10.

In response to the Examiner’s rejection, Appellants argue that the claims recite tangible objects that make the claims patent eligible. Br. 13–16. Specifically, Appellants assert:

The examiner states that a playing surface is not a “machine per se that can be set in motion to accomplish a predetermined result.” However, the examiner’s restatement of the test is incomplete. A claimed process is patent eligible if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.

Br. 13–14.

The Supreme Court set forth a “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 132 S. Ct. 1289, 1294 (2012)). According to the Supreme Court’s framework, we must first determine whether the claims at issue are directed to one of those concepts (i.e., laws of nature, natural phenomena, and abstract ideas). *Id.* If so, we must secondly “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* The Supreme Court characterizes the second step of the analysis as “a search for an ‘inventive concept’ — i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (alteration in original). To transform an abstract idea into a patent-eligible concept, the claims require “more than simply stating the abstract idea while adding the words ‘apply it.’” *Id.* at 2357 (citations omitted).

For the *Alice* step one, the Examiner finds that claims 16–33 are directed to an abstract idea for the “rules for playing a game.” *See, e.g.*, Final Act. 5; 6 (“the claims are considered ‘rules’ for playing a game that can be performed by human thought alone and, as such, is considered merely an abstract idea”). Appellants do not contest the Examiner’s determination in this regard, and, thus, do not identify any error by the Examiner. We also note that Appellants’ claims compare to other “rules” for human activity

found abstract by the Federal Circuit. *See, e.g., In re Smith*, 815 F.3d 816 (Fed. Cir. 2016) (determining that rules for playing physical cards are abstract ideas); *Planet Bingo, LLC v. VKGS LLC*, 576 Fed. Appx. 1005, 1007–08 (Fed. Cir. 2014) (determining that methods of managing a bingo game are abstract ideas); *In re Brown*, 645 Fed. Appx. 1014, 1016–17 (Fed. Cir. 2016) (determining that a method of cutting hair using scissors is an abstract idea) (non-precedential). Accordingly, claims 16–33 are directed to an abstract idea.

For the *Alice* step two, having determined that claims 16–33 are directed to an abstract idea, we must determine whether the claims contain additional elements that transform the claims into patent-eligible subject matter. Appellants argue that the recitation of the “physical objects” (e.g., playing surface (claim 16), computer processor (claims 31, 20), input device (claim 31), display screen (claims 17, 31), answer card (claim 18), keyboard (claim 19), game board (claim 21), game surface (claim 22), playing surface (claim 23), display surface (claim 24)) brings the claims within patent-eligible territory. Appeal Br. 13–16.

Appellants’ arguments are not persuasive. In *Smith*, for example, the Federal Circuit determined that using, shuffling and dealing physical playing cards (i.e., arranging answer choices on a playing surface, game board, or display screen), and determining a winner by comparing a player’s physical cards to a dealer’s reference cards (i.e., processor for selecting winning answer choice and presenting an award) are “purely conventional” activities. *In re Smith*, 815 F.3d at 819. Appending purely conventional steps to an abstract idea does not supply a sufficiently inventive concept. *Id.* In *Planet Bingo*, the Federal Circuit also determined that using generic

implementation of a computer (e.g., computer processors, input terminal, display screens) to apply an abstract idea related to rules of a game does not impart patent eligibility. *In re Planet Bingo*, 576 Fed. Appx. at 1007–08. Here, Appellants’ “physical objects” are not the type of additional features *Alice* envisioned as imparting patent eligibility. *See Alice*, 134 S.Ct. at 2358 (“[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea while adding the words ‘apply it’ is not enough for patent eligibility.”) (quoting *Mayo*, 132 S.Ct. at 1294 (internal quotation marks omitted)). Here, as was the case in *Alice*, for purposes of analyzing claims 31–33 under § 101, “the system claims are no different from the method claims in substance.” *See Alice*, 134 S.Ct. at 2360; *see also* Final Act. 8 (citing *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1374 (Fed. Cir. 2011)).

Claims 16–33, when considered “both individually and ‘as an ordered combination,’” amount to nothing more than an attempt to patent the abstract ideas embodied in the steps of the claim. *See Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1298). Accordingly, the limitations of these claims fail to transform the nature of this claim into patent-eligible subject matter. *See id.* (citing *Mayo*, 132 S. Ct. at 1297, 1298).

The rejection of claims 16–33 under 35 U.S.C. § 101 is sustained.

DECISION

For the above reasons, the Examiner's rejections of claims 16–33 are
AFFIRMED.

No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED